

REMARKS

Claims 7-10, 14, 15, 19, 20, 24, 25, and 29 are pending upon entry of this amendment. Claims 1-6 remain withdrawn from consideration. Claim 15 has been amended to correct a typographical error. Support for the amendment can be found on page 21, lines 24-29 of the specification. Claims 30-33 have been canceled without prejudice or disclaimer.

Rejections Under 35 U.S.C. § 102 in view of Murakami

Claims 30-33 were rejected under 35 U.S.C. § 102(b) as being anticipated by Murakami (U.S. Patent No. 4, 624,667). The claim amendments described above render the rejections moot. Withdrawal of the rejections is therefore requested.

Rejections under 35 U.S.C. § 103(a) over Fukuda in view of Shibuya

Claims 7-10, 15, 20, 23 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukuda (U.S. Patent No. 4,985,538) in view of Shibuya (U.S. Patent No. 5,270,390). Applicants respectfully traverse.

To establish a *prima facie* case of obviousness, the Federal Circuit has stated that a reference must (1) suggest to or provide motivation for one of ordinary skill in the art to make the claimed invention; (2) provide one of ordinary skill with a reasonable expectation of success in so making, and (3) teach all the present claim limitations; *See In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991) (*citing In re Dow Chemical Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988)); *see also* M.P.E.P. 2143. In the present case, the Examiner has failed to establish any of these three prongs.

1. No Motivation to Combine Fukuda and Shibuya

As the Examiner agreed, Fukuda discloses a film having a shrinkage of 30% or more in the main shrinkage direction when the film is put in water at 75 °C for 5 seconds, and the shrinkage in the direction perpendicular to the main shrinking direction is 20% or less (column 6, lines 50-58). Office Action, page 4. Applicants further point out that Fukuda sets a maximum shrinkage rate in the direction perpendicular to the main shrinking direction. See

column 2, lines 8-10 (**not more than 20%** in the other direction after 5 sec treatment in a warm water of 75 °C); column 4, lines 39-43 (after treating the film for 5 min in an air oven at 100 °C ... shrinkage of the film in the other direction is **not more than 20%**) ; column 4, lines 52-56 (film... is unsuitable ... where the shrinkage in the other direction is over 20% because the deformation of the drawing or letter printed on the film is caused.); column 6, lines 61-64; column 8, line 61-column 9, line 3 (shrinkage after treating the film for 5 min in an air oven at 100 °C is preferably **not more than 15%**, ..., The film showing the shrinkage of over 15% ... is undesirable.) On the other hand, Shibuya states that “heat shrinkable film with single layer being applicable for practical use requires heat shrinkage percent of **over 20% in the direction of both length and breadth...**” (column 11, lines 25-29). In fact, all of the examples disclosed in Shibuya have a heat shrinkage rate of **at least 40% in both directions**. See Examples 1-4 in Table 1 and Examples 5-14 in Table 2. As a result, Shibuya explicitly teaches away from Fukuda. The proposed modification by Shibuya would render Fukuda unsatisfactory for its intended purpose. Therefore, there could be no motivation for one of ordinary skill in the art to combine them.

2. No Reasonable Expectation of Success

Assuming, *arguendo*, that Fukuda and Shibuya are to be combined, however, because they point to opposite directions in terms of the shrinkage rate, as discussed above, there could be no reasonable expectation of success in either direction.

3. Present Claim Limitations Not Met

At least four of the claim limitations for claims 7-10, 15, 20, and 25 are not met by Fukuda, Shibuya, or the combination thereof. These limitations include:

- (a) Shrinkage of about 10% to about 40% along its main shrinkage direction in water of 70°C for 5 seconds;
- (b) Shrinkage of about 50% or more along its main shrinkage direction in water of 95°C for 5 seconds;
- (c) Shrinkage of about 10% or less along a direction perpendicular to its main shrinkage direction in water of 95°C for 5 seconds; and
- (d) Adhesive retention of about 95% or more after shrinkage.

The Examiner has acknowledged that Fukuda fails to disclose (a), (b), and (c). Office Action, page 4, lines 7-12. Applicants further submit that in addition to Shibuya's teaching away from (c), as discussed above, it does not teach (a) or (b) either. Shibuya's states that "heat shrinkage percent below 15% at 90 °C is unfavorable" (column 8, lines 24-25) and requires "heat shrinkage percent of over 20% in the direction of both length and breadth." However, such limitation is not identical or equivalent to limitations (a) and (b) as presently claimed. For example, each of Examples 1-4 in Shibuya has shrinkage percentage between 40 – 50% (Table 1), which meets neither limitation (a) or (b).

Moreover, neither Fukuda nor Shibuya discloses limitation (d). Adhesive retention is not discussed in the references at all. Shibuya discloses a film comprising a polyester resin, a polyester elastomer, and PVDC, the disclosed film having superior gas barrier properties (column 3, lines 21-28). The presently claimed films do not contain PVDC. Applicants assert that gas barrier properties attained by Shibuya are not equivalent to adhesive retention after shrinkage attained by the claimed invention. Applicants also respectfully point out that adhesive retention of 95% or more as presently claimed is a property of the film that can be measured by the standard as set forth in the specification and in the claims. A standard of determining the defectiveness of film based on whether the bond is partially or totally peeled, or can easily be peeled by hand, is an objective one.

Additionally, Applicants submit that the film disclosed in Fukuda has different properties than those of the presently claimed films. Firstly, the presently claimed films may be subjected to heat shrinkage temperatures of as high as 200 °C, while Fukuda fails to disclose that such is possible, only indicating that the disclosed films are subjected to shrinkage temperatures of 75 - 100 °C. Secondly, in addition to Fukuda's failure to disclose limitation (a), it is not inherent that films disclosed by Fukuda have the shrinkage properties as presently claimed. For example, as stated in the Declaration of Masatoshi Hashimoto dated July 24, 2003, Example 14 of Fukuda has a shrinkage rate of 49% along its main shrinkage direction in water of 70°C for 5 seconds, which is outside the claimed range of about 10 to about 40%. As a result of the differing properties between the presently claimed films and those disclosed in Fukuda, the claimed films can be used in applications which are not possible with the films of Fukuda. For example, one preferred embodiment of the invention is a film having a compressive strength of about 300 g or more (specification, page

22, lines 24-32), which allows the film to be used in labeling apparatuses with a speed 2-3 times faster than that would be possible with the films of Fukuda.

For at least the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Claims 7-10, 15, 20, 23 and 25 are patentable over Fukuda, Shibuya, and the combination thereof. Withdrawal of the rejections is respectfully requested.

Rejections under 35 U.S.C. § 103(a) over Fukuda in view of Shibuya and Yoshinaka

Claims 14, 19, 24, and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda in view of Shibuya and further in view of Yoshinaka (U.S. Patent No. 4,996,291). Applicants respectfully traverse.

The deficiencies of Fukuda and Shibuya, as discussed above, are not corrected by Yoshinaka. Furthermore, neither Fukuda nor Shibuya teaches or suggests a cap sealing label. Yoshinaka discloses a film that is “used for covering the cap ... for the purpose of labeling ...,” (column 1, lines 22-25) which is not equivalent to a cap **sealing** label. Neither does Yoshinaka provide a motivation to use Fukuda and Shibuya to make a cap sealing label.

Moreover, the adhesive retention after shrinkage property, as claimed in the present invention, permits the claimed films to be used advantageously for cap sealing labels. Such property is not taught or suggested by the Fukuda, Shibuya, Yoshinaka, or the combination thereof.

For at least the above reasons, claims 14, 19, 24, and 29 are patentable over Fukuda, Shibuya, Yoshinaka, and the combination thereof. Withdrawal of the rejections is respectfully requested.

CONCLUSION

Applicants submit that the claims as presently written are allowable and an early and favorable action to that effect is respectfully requested.

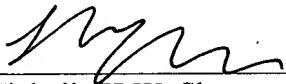
The Examiner is invited to contact the undersigned at (202) 220-4200 to discuss any information concerning this application.

The Office is hereby authorized to charge the fee for an Extension of Time and any additional fees under 37 C.F.R. 1.16 or 1.17 or credit any overpayment to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully submitted,

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By:



Michelle H.W. Shen
Reg. No. 48,823

KENYON & KENYON LLP

1500 K Street, N.W., Suite 700
Washington, D.C. 20005
(202) 220-4200 telephone
(202) 220-4201 facsimile